

Application: 10/035,516

Attorney Docket No. 112.P14195

**REMARKS**

The current patent application has been reviewed in light of the Office Action, referenced above (hereinafter "the office action"). In the office action, claims 1, 3, 11-14, 17-19, 30-33, and 35 were rejected under 35 U.S.C. §102(b) as being anticipated by Seto, U.S. Patent No. 5,124,810 (hereinafter "Seto"), claims 2 and 20-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco et al., U.S. Patent No. 6,064,778 (hereinafter "Pasco"), claims 4-6, 15, 16, and 34 were rejected under 35 U.S.C. §103(a) over Pasco, claims 7-10 were rejected under 35 U.S.C. §103(a) over Pasco in view of what the Examiner contends is well known art, and claims 25-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco in view of what the Examiner contends is well known art. Entry and consideration of this amendment and response is respectfully requested.

Claims 1-55 are currently pending. Claims 36-55 have been added. No new matter has been added. Claims 1-18 have been amended. Assignee has amended claims to more clearly delineate intended subject matter. The amendments to the claims are made without prejudice or disclaimer, and Assignee believes that none of these claim amendments constitute narrowing amendments. Accordingly, Assignee does not intend to surrender claimed subject matter by submission of the above amendments and no prosecution history estoppel should apply.

**Claim Rejections Under 35 U.S.C. §102(b)**

Claims 1, 3, 11-14, 17-19, 30-33, and 35 are rejected under 35 U.S.C. §102(b) as being anticipated by Seto. However, Seto does not disclose capturing a first image of a document at a first position, feeding the document a length less than a total length of the document to a

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second position, and capturing a second image of the document at the second position. For example, Seto does not claim

"feeding the document an appropriate length to a second position, wherein the appropriate length comprises a length that is less than a total length of the document;  
capturing a second image of the document while said document is in said second position"  
(amended claim 1).

To the contrary, Seto clearly discloses reading image information at the beginning and end of image reading of a document. Seto discloses

"...and the skew detection circuit 42 discriminates whether the difference between the first input signal and the second input signal has exceeded a predetermined limit or not. The first input signal corresponds to the position x1 detected at the beginning of the image reading and the second input signal corresponds to the position x2 detected at the end of the image reading." emphasis added  
(column 15, lines 12-19)

Therefore, Seto does not disclose an appropriate length that is less than a total length of a document, as claimed in claim 1, and claim 1 is not anticipated by Seto.

Claim 18 includes elements similar to those mentioned above in connection with claim

1. Therefore, claims 1 and 18, and the claims that depend from them, are not anticipated by Seto. Assignee respectfully requests that the Examiner withdraw the rejection to claims 1, 3, 11-14, 17-19, 30-33, and 35.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient.

#### **Claim Rejections Under 35 U.S.C. §103(a)**

Claims 2 and 20-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco, claims 4-6, 15, 16, and 34 are rejected under 35 U.S.C. §103(a) over

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Pasco, claims 7-10 are rejected under 35 U.S.C. §103(a) over Pasco in view of what the Examiner contends is well known art, and claims 25-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco and in view of what the Examiner contends is well known art.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Assignee's disclosure." MPEP § 2143. Assignee respectfully submits that the Examiner has not established a *prima facie* case of obviousness. The cited patents do not teach or suggest all the limitations of the aforementioned claims.

Neither Pasco nor Seto disclose, either alone or in combination, an appropriate length for feeding a document that is less than a total length of a document, as discussed above in connection with claim 1. Claim 18 includes similar limitations. Therefore, claims 1 and 18 and the claims that depend from them are patentably distinguished over the cited patents. Assignee respectfully requests that the Examiner withdraw his rejections to the aforementioned claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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**CONCLUSION**

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Entry of this amendment and reconsideration of the present patent application in view of the same, and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

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